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UBER, NATHAN C				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/568,753

Applicant(s)

MEBRUER, ROBERT

Examiner

NATHAN C. UBER

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 17-23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 17-23 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on 28 October 2008.
2. Claims 1, 7, 10, 11, 17, 21 and 25 have been amended.
3. Claims 12-16, 24 and 26 have been canceled.
4. Claims 1-11, 17-23 and 25 are currently pending and have been examined.

Continued Examination Under 37 CFR 1.114

5. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 28 October 2008 has been entered.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. Claims 7 and 21 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Applicant has addressed this rejection by amendment, the rejection therefore is withdrawn.
8. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 17 recites the limitation "the first processor" in the limitation *at a central station, comprising a second processor in communication with a....* There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 3622

9. Claims 1, 3, 6, 17, 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims all contain one or more of the following acronyms: EPOS, RFID and PDA. Any acronym used in a series of claims must be defined the first time it is used in that claim series to avoid any possible indefiniteness that may result from the use of an undefined acronym.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 17, 18, 20-23 and 25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 17, 18, 20-23 and 25 fail to meet the above requirements because they are neither tied to a second statutory class of invention nor do they transform underlying subject matter. Examiner notes the disclosure of statutory subject matter, a *central station* and an *EPOS terminal* in claim 17; however, the method steps associated with these limitations are not sufficiently tied to the devices. As claimed, the devices are not actually doing any of the method steps that are the subject of the claim.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

15. Claims 1-6, 8, 9, 11, 17-20 and 22-23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Millikan (U.S. 2003/0105667) in view of Avallone et al. (U.S. 2002/0147642) and in view of Sloane (U.S. 5,918,211).

Claim 1:

Millikan, as shown, discloses the following limitations:

- *a plurality of retail locations each having a detection device for detecting data uniquely related to consumer, in proximity to a location where merchandise is*

available to the detected consumer, without requiring interaction by the detected consumer (see at least ¶0024, "...a consumer detection and/or identification system...", "...the consumer does not need to do an activity" to be detected by the system"),

- an output device for supplying a message to a detected consumer, providing specific offers available at the location to the consumer (see at least ¶0021, "...a plurality of message providers..." see also at least ¶0033, wireless devices for presentation of advertisements/offers to consumer, Examiner notes that the offers and advertisements presented by the Millikan invention are specific to the store/location see at least ¶0029),*
- whereby the detected consumers is able to receive offers at the location without physical interaction on his or her part, and to avail himself or herself of the offers contained in the message supplied at the location (see at least ¶0026, "...system does not require active participation by the consumer..."),*
- a first processor for generating a plurality of available offers and for identifying in a list specific ones of said plurality of offers that are applicable to a detected consumer based on data stored in a database relating to characteristics of the detected consumer, (see at least Figure 16, Item 20, see also at least ¶0029 generating targeted advertisements based on the characteristics of the customers identified/detected),*
- an EPOS terminal connected with the second server so that offers supplied by said message to a particular consumer are transmitted from the first server to the second server and then to the EPOS terminal so that when a consumer identifies himself or herself at the EPOS terminal, purchases made by the consumer are provided in accordance with the offers supplied to the consumer (see at least ¶0027, "retail terminals... used to consummate retail or purchase transactions" and ¶0032, "during checkout at a retail terminal"),*

Millikan discloses a retail transaction terminal, but Millikan does not specifically disclose the common knowledge step of downloading coupon/special offer information to the retail transaction terminals so that a consumer that receives a special offer can actually obtain the offer. In a previous Office action Examiner took **Official Notice** that it is old and well known in the art to associate coupon and other customer incentive databases with a POS machine such that coupons are applied or downloaded to the POS for example upon swiping a customer/loyalty card. Further Examiner refers Applicant to the Sloane reference (U.S. 5,918,211) which teaches "[a] [r]etail computer/controller programmed to receive and store the promotional information sent by the retailer or sender, and can therefore offer the promotions at the appropriate time and to the appropriate consumer" (column 7, lines 22-26), and teaches sending targeted promotions to specific customers and immediately recording the discount at a computer/controller which is linked to the point of sale terminal that is additionally programmed to record shopping history and apply carry-over promotions to the order (column 8, lines 41-63). Examiner notes that the Sloane patent is directed primarily to a portable scanner that a consumer carries throughout a retail location. The Sloane scanner receives promotions targeted to the consumer and, as shown, it automatically applies the discounts offered to the consumer when the consumer selects the advertised product. Therefore this teaching of Sloane, albeit not necessarily the physical device of Sloane, is analogous to this invention and teaches the limitations which Applicant believes are not specifically taught by Millikan and Avallone.

Additionally Millikan does not specifically disclose multiple servers as in the limitations below, however, Avallone, as shown, does:

- *so that from the plurality of available offers, those specific offers, which relate to the detected consumer based on characteristics of the detected consumer are assembled and presented respectively to the individual consumer* (see at least ¶0054, portable display units receive personalized information for

display to customers, see also at least ¶¶0094 and 0096, providing customer specific advertising and offers),

- *the first processor comprises a first server for receiving the target file of offers (see at least ¶0059, "...the server's controller... enables the first server to access, read from, write to, and/or manipulate personalized information contained in one or more databases, communicate with a transmitter... communicate with one or more mainframe microprocessors... which are disposed locally or, more preferably, remotely from the commercial establishment"),*
- *a second server associated with the location being connected to the first server, and (see at least ¶0060, "[t]he second server communicates with the first server..."),*
- *a central station, comprising a second processor in communication with the first processor in each of said retail locations and operative to develop a target file of offers for at least one detected consumer and to provide said target file to at least said first processor (see at least ¶0059, "...the server's controller... enables the first server to access, read from, write to, and/or manipulate personalized information contained in one or more databases, communicate with a transmitter... communicate with one or more mainframe microprocessors... which are disposed locally or, more preferable, remotely from the commercial establishment" and ¶¶0058 and 0061 describing the data contained in databases on the servers),*

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the targeted advertising system of Millikan with the old and well known technology disclosed by Avallone (networking capabilities, including multiple servers, remote and local servers) and with the old and well known advertising techniques of Sloane (including presenting offers to customers and processing

transactions so that the customer receives the discount in the offer) since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claims 2 and 18:

The combination Millikan/Avallone/Sloane discloses the limitations as shown in the rejection above. Further Millikan, as shown, discloses the following limitations:

- *said retail location is a retail outlet, a mall, a food court or an event area (see at least ¶0021, "...establishment... such as a retail store...").*

Claim 3:

The combination Millikan/Avallone/Sloane discloses the limitations as shown in the rejection above. Further Millikan, as shown, discloses the following limitation:

- *the detection device comprises an RFID (radio frequency identification device) reader for reading an RFID tag carried by the consumer to identify a particular consumer (see at least ¶0024, "...detection... system may be a... field generator/detector that is operative to detect an identification card such as a transponder type card or a smart card...", RFID readers are **Inherent** to smart card and transponder technology).*

Claim 4:

The combination Millikan/Avallone/Sloane discloses the limitations as shown in the rejection above. Further Millikan, as shown, discloses the following limitation:

- *the RFID tag can provide a unique code which provides a unique identification of an individual consumer so that individual consumers can be identified and distinguished from one another (see at least ¶0024, "...card may include the consumer information thereon, or provide consumer identification data...").*

Claim 5:

The combination Millikan/Avallone/Sloane discloses the limitations as shown in the rejection above. Further Millikan, as shown, discloses the following limitation:

- *the RFID tag is contained in a card carried by the consumer* (see at least ¶0024, "...an identification card such as a transponder type card or a smart card...").

Claim 6:

The combination Millikan/Avallone/Sloane discloses the limitations as shown in the rejection above. Further Millikan, as shown, discloses the following limitations:

- *the output device comprises a transmitter* (see at least ¶0027, "...a message generator and transmitter..."),
- *for wireless transmission of the message to the individual consumer's mobile telephone or PDA* (see at least ¶0033, "...a wireless configuration... a PDA of the like...").

Claim 8 and 22:

The combination Millikan/Avallone/Sloane discloses the limitations as shown in the rejection above. Further Avallone, as shown, discloses the following limitation:

- *output device is a printer for printing a document containing the offer* (see at least ¶0055, "... a printer for printing out, e.g., discount coupons..."),

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the targeted advertising system of Millikan with the device of Avallone to allow customers to print desired ads or coupons because electronic devices such as cellular phones and PDAs have limitations such as memory or power that limit a customers accessibility to coupons provided thereon, a printing means helps a customer retain a coupon as well as free-up memory on his/her mobile device.

Claim 9:

The combination Millikan/Avallone/Sloane discloses the limitations as shown in the rejection above. Further Millikan, as shown, discloses the following limitation:

Art Unit: 3622

- *the first processor receives a target file of offers for individual consumers from the central station, the target file of offers being based on data held at the central station relating to personal information associated with individual consumers (see at least ¶0028, the message targeting system ascertains consumer characteristics from the identification system and storage, and ¶0029, uses the characteristics to select a message... the messages may be provided by outside sources such as vendors),*

Millikan does not specifically disclose a central station, or a remote server that serves multiple stores, however, Avallone, as shown, does:

- *central station (see at least ¶0059, "...the server's controller... enables the first server to access, read from, write to, and/or manipulate personalized information contained in one or more databases, communicate with a transmitter... communicate with one or more mainframe microprocessors... which are disposed locally or, more preferably, remotely from the commercial establishment" and ¶¶0058 and 0061 describing the data contained in databases on the servers),*

Examiner further notes that in ¶0060 the second server may be local or remote from the retail store and it contains databases described in ¶0061 (including customer, weekly specials, etc.) all of which are accessed by the in-store system whether the server itself is local or remote. Further the cited references teach that all of the servers may be remote or local to the retail store, therefore the processes that they perform may also occur remotely or locally.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the targeted advertising system of Millikan with the networking capabilities, including multiple servers and remote servers, disclosed by Avallone because networking remote servers hosting common use databases (i.e. information that is not particular to a specific store) such as customer information databases and

advertising storage present numerous efficiencies to the Millikan invention such as avoiding duplication of equipment and data, improving data accuracy and reducing system installation costs.

Claims 11 and 25:

The combination Millikan/Avallone/Sloane discloses the limitations as shown in the rejection above. Further, Millikan, as shown, discloses the following limitation:

- *the consumer identifies himself or herself by displaying the message to a person at the EPOS terminal, or by swiping a card which contains the user's identifying data at the EPOS terminal (see at least ¶0032, "...swiping of the customer card...").*

Claim 17:

Millikan, as shown, discloses the following limitations:

- *at each of a plurality of locations detecting consumers in proximity to a location where merchandise is available to the consumers, without requiring interaction by the consumers (see at least ¶0026, "consumer detection and/or identification system does not require active participation by the customer...", see also at least ¶0024 "...the consumer does not need to do an activity" to be detected by the system"),*
- *generating a plurality of available offers and identifying specific ones of said plurality of offers that are applicable to a detected consumer based on data stored in a database relating to characteristics of the detected consumer, from the plurality of available offers (see at least Figure 16, Item 20, see also ¶0029 generating targeted advertisements based on the characteristics of the customers identified/detected),*
- *outputting a message to a detected consumer providing the specific offers available at the location to the consumer (see at least ¶0013, "...provides targeted advertisements to consumers... at a particular location"),*

Art Unit: 3622

- *whereby the detected consumer is therefore able to receive offers without physical interaction on his or her part, and to avail himself or herself of the offers contained in the message at the location (see at least ¶0026, "...system does not require active participation by the consumer..."),*
- *transmitting said specific offers to an EPOS terminal at said location so that when a consumer identifies himself or herself at the EPOS terminal, purchases made by the consumer are provided in accordance with the specific offers contained in the message to the consumer (see at least ¶0027, "retail terminals... used to consummate retail or purchase transactions" and ¶0032, "during checkout at a retail terminal"),*

Millikan discloses a retail transaction terminal, but Millikan does not specifically disclose the common knowledge step of downloading coupon/special offer information to the retail transaction terminals so that a consumer that receives a special offer can actually obtain the offer. In a previous Office action Examiner took **Official Notice** that it is old and well known in the art to associate coupon and other customer incentive databases with a POS machine such that coupons are applied or downloaded to the POS for example upon swiping a customer/loyalty card. Further Examiner refers Applicant to the Sloane reference (U.S. 5,918,211) which teaches "[a] [r]etail computer/controller programmed to receive and store the promotional information sent by the retailer or sender, and can therefore offer the promotions at the appropriate time and to the appropriate consumer" (column 7, lines 22-26), and teaches sending targeted promotions to specific customers and immediately recording the discount at a computer/controller which is linked to the point of sale terminal that is additionally programmed to record shopping history and apply carry-over promotions to the order (column 8, lines 41-63). Examiner notes that the Sloane patent is directed primarily to a portable scanner that a consumer carries throughout a retail location. The Sloane scanner receives promotions targeted to the consumer and, as shown, it automatically applies the discounts offered to the consumer

Art Unit: 3622

when the consumer selects the advertised product. Therefore this teaching of Sloane, albeit not necessarily the physical device of Sloane, is analogous to this invention and teaches the limitations which Applicant believes are not specifically taught by Millikan and Avallone.

Millikan does not specifically disclose the following limitations. Avallone, as shown, discloses the following limitations:

- *assembling those specific offers which relate to the detected consumer based on the characteristics of the detected consumer, and presenting said specific offers respectively to individual consumers (see at least ¶0054, portable display units receive personalized information for display to customers),*
- *at a central station, comprising a second processor in communication with the first processor in each of said retail locations, developing a target file of offers for at least one detected consumer and to provide said target file to at least said first processor (see at least ¶0059, "...the server's controller... enables the first server to access, read from, write to, and/or manipulate personalized information contained in one or more databases, communicate with a transmitter... communicate with one or more mainframe microprocessors... which are disposed locally or, more preferable, remotely from the commercial establishment" and ¶¶0058 and 0061 describing the data contained in databases on the servers),*

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the targeted advertising system of Millikan with the old and well known technology disclosed by Avallone (networking capabilities, including multiple servers, remote and local servers) and with the old and well known advertising techniques of Sloane (including presenting offers to customers and processing transactions so that the customer receives the discount in the offer) since the claimed

invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 19:

The combination Millikan/Avallone/Sloane discloses the limitations as shown in the rejection above. Further Millikan, as shown, discloses the following limitations:

- *detecting consumers comprises detecting an RFID tag carried by the consumer with an RFID reader to identify a particular consumer (see at least ¶0024, "...detection... system may be a... field generator/detector that is operative to detect an identification card such as a transponder type card or a smart card...", RFID readers are **Inherent** to smart card and transponder technology).*

Claim 20:

The combination Millikan/Avallone/Sloane discloses the limitations as shown in the rejection above. Further Millikan, as shown, discloses the following limitations:

- *outputting the message comprises wireless transmission of the message to the individual consumer's mobile telephone or PDA (see at least ¶0033, message providers may communicate wirelessly and may include a PDA or "the like").*

Claim 23:

The combination Millikan/Avallone/Sloane discloses the limitations as shown in the rejection above. Further Millikan, as shown, discloses the following limitations:

- *receiving a target file of offers for individual consumers from the central station (see at least ¶0029, "the message targeting system is operative to accept messages, modify messages... messages may be provided by outside sources...),*

Art Unit: 3622

- *the target offers being based on data held at the central station relating to personal information associated with individual consumers* (see at least ¶¶0030, "a message is considered targeted in that it relates to the deemed characteristics of a majority of the consumers currently at the establishment..."),

Millikan does not specifically disclose a central station, or a remote server that serves multiple stores. However, Avallone, as shown, discloses the following limitations:

- *from a central station* (see at least ¶¶0059, "...the server's controller... enables the first server to access, read from, write to, and/or manipulate personalized information contained in one or more databases, communicate with a transmitter... communicate with one or more mainframe microprocessors... which are disposed locally or, more preferable, remotely from the commercial establishment" and ¶¶0058 and 0061 describing the data contained in databases on the servers).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the targeted advertising system of Millikan with the networking capabilities, including multiple servers and remote servers, disclosed by Avallone because networking remote servers hosting common use databases (i.e. information that is not particular to a specific store) such as customer information databases and advertising storage present numerous efficiencies to the Millikan invention such as avoiding duplication of equipment and data, improving data accuracy and reducing system installation costs.

16. Claims 7, 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Millikan (U.S. 2003/0105667) in view of Avallone et al. (U.S. 2002/0147642) and in view of Sloane (U.S. 5,918,211) and further in view of **Official Notice**.

Claim 10:

Art Unit: 3622

The combination Millikan/Avallone/Sloane discloses the limitations as shown in the rejection above. Millikan does not specifically disclose a retail server. However, Avallone, as shown, discloses the following limitation:

- *a retail server, comprising an inventory system and a consumer data base, in communication with each of said first processor and said second processor, and operative to provide price, inventory and consumer data for processing by said first and second processors (AVALONE ¶0061, server includes lists and databases of specials, promotional items, product locations, etcetera),*

Avallone does not specifically mention networking inventory databases to the POS. However, Examiner takes **Official Notice** that it is old and well known in the art to network inventory databases (such as those relying on the UPC bar code information for product identification) with POS terminals in stores. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the targeted advertising system of Millikan with the networking capabilities, including multiple servers and remote servers, disclosed by Avallone and to further network a store inventory, POS and customer reward system because networking remote servers hosting common use databases (i.e. information that is not particular to a specific store) such as customer information databases and advertising storage with store specific databases and POS data (especially if they already exist in an establishment) present numerous efficiencies to the Millikan invention such as avoiding duplication of equipment and data, improving data accuracy and reducing system installation costs.

Claims 7 and 21:

The combination Millikan/Avallone/Sloane discloses the limitations as shown in the rejection above. Millikan does not disclose the following limitation:

- *the message is an SMS (short message service), EMS (enhanced message service) or MMS (multimedia message service) message,*

However, Examiner takes **Official Notice** that it is old and well known in the art that messages sent to mobile phones and PDAs may be SMS, EMS or MMS. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to send text messages to a mobile phone or PDA rather than audio/video messages or in addition to audio/video data (see at least ¶0029) because text messages can be distributed faster and cheaper and require less memory for storage both on a store's servers and on a recipient's device.

Response to Arguments

17. The rejection above was updated to reflect Applicant's amendments to the claims. Applicant's arguments with respect to claims 1 and 17 have been considered but are moot in view of the new grounds of rejection.
18. With regard to Applicants arguments with respect to claims 2-6, 8, 9, 18-20, 22, 23, and 25, Applicant requested "to the extent that Examiner may use 'Official Notice' to remedy the deficiencies of Millikan and Avallone[, that Examiner] provide prior art references and identify their pertinent teachings that disclose (1) the provision of specific offers to an individual detected consumer and (2) transmitting any such individually delivered specific offers to an EPOS terminal so that purchases subsequently made by the consumer are provided in accordance with the specific offers in the message to the consumer." Examiner notes that Examiner did not rely on official notice in this Office action or in any previous Office actions to teach those limitations. The above rejections address those limitations above including the newly added *specific offer* limitations.
19. As shown in the rejections above, Examiner relied on official notice to teach the following: networking inventory databases (such as those relying on the UPC bar code information for product identification) with POS terminals in stores; to teach messages sent to mobile phones and PDAs may be SMS, EMS or MMS; and to teach associating coupon and other customer incentive databases with a POS machine such that coupons are applied or downloaded to the

Art Unit: 3622

POS for example upon swiping a customer/loyalty card. Because applicant failed to traverse the examiner's assertions of official notice the common knowledge or well-known in the art statements are taken to be admitted prior art. To adequately traverse such a finding of official notice, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.") (MPEP 2144.03(c)).

Art Unit: 3622

Conclusion

20. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.
21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
22. Any response to this action should be mailed to:

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P.O. Box 1450, Alexandria, VA 22313-1450

or faxed to **571-273-8300**.

23. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

Randolph Building
401 Dulany Street
Alexandria, VA 22314.

/Nathan C Uber/ Examiner, Art Unit 3622
10 December 2008

/Arthur Duran/
Primary Examiner, Art Unit 3622